

REMARKS

Claims 2-11, 13-16, 18, and 20 were pending as of the action mailed July 24, 2006.
Claims 2, 13-16, and 18 are being amended. No new matter has been added.
Reconsideration and re-examination are requested in light of the following remarks.

Section 112 Rejections

The examiner rejected claim 13 and its dependent claims, stating that claim 13 recites the limitation "carrier instructions", which the examiner does not find described in the specification. The problem here is that the examiner has parsed the claim language incorrectly. The applicant respectfully submits there is no sensible way to parse the entire preamble that leaves "carrier instructions" as a unit. The units are: (1) "product, tangibly embodying in an information carrier" and (2) "instructions operable to cause a computer to perform operations." The words "an information carrier" belong together, and one cannot join "instructions" to them as a unit because the article "an" requires a singular noun and "instructions" is plural. Having the article "an" modify only the noun "information" would be contrary to normal English usage. Therefore, the object of the preposition "in" must be "an information carrier" and cannot include "instructions".

Thus, the limitation that the examiner identified does not actually exist in the claim and the rejection should be withdrawn.

The examiner rejected claims 2-11, 13-16, 18, and 20 as allegedly being indefinite. The examiner stated that "it is unclear whether the limitations following ['allowed'] are part of the claimed invention." The limitations in question appear in independent claims 2 and 13. The first instance in each claim reads, "wherein the user is allowed to fast-forward the first video data but is not allowed to fast-forward the second video data."

The applicant has amended claims 2 and 13 to delete the foregoing language. That the user is allowed to fast forward only some of the video data is expressed later in each claim with the limitation, "the user being allowed to fast-forward any video data stored on the first member but not being allowed to fast-forward any video data stored on the second member." This latter language was added to claims 2 and 13 in response to the examiner's statement in the previous

action that the dependent claims 17 and 19, from which the language was taken, would be allowable if presented in independent form.

The examiner now seems to say that the claims appear “to cover anything and everything that does not prohibit actions from occurring.” This statement is at odds with the clear language of the claims. The claims do prohibit very particular actions from occurring, as well as causing other actions to occur. In fact the claims recite the actions in positive way, reciting that “notwithstanding the request” to bypass the data, the second video data is streamed to the user. Thus, the examiner’s statement that the claims appear “to cover anything and everything” is incorrect.

For each of the foregoing reasons, the rejection of claims 2-11, 13-16, 18, and 20 should be withdrawn.

Section 101 Rejections

Claims 2 and 13 were rejected under Section 101 “because we have held that the claimed subject matter does not fall within the definition of a ‘process’ under § 101 and is an ‘abstract idea,’ and, therefore, it is not a ‘practical application’ of the plan because it does not produce a ‘concrete and tangible result’.

The applicant is surprised by this rejection. The examiner’s statement that “we have held” is puzzling, because this is the first time this rejection has been made in this application, and the examiner had previously indicated that claims with the limitations in question were allowable. In fact, claims 2 and 13 were amended to read as they now do because the examiner had indicated that this would put them in condition for allowance.

Second, claim 13 is not directed to a process. Rather, it is directed to a computer program product.

Third, the applicant cannot tie the examiner’s reference to “the plan” to anything in the claims.

Fourth, the reference to “claims 1-30”, which do not exist in the present application, suggests to the applicant that the present rejection belongs to a different application entirely.

For each of the foregoing reasons, the rejection should be withdrawn.

As to whether the claimed method and product produce a tangible and concrete result, the applicant respectfully submits that under and reasonable reading of the language of the claim, such a result is clearly present. The independent claims recite that first video data of a video is stored on a first member of a data storage and second video data of the video is stored on a second member of the data storage, that the video is streamed to a user, that a request to fast-forward the video that attempts to bypass the second video data is received from a user and this attempt is detected, and that notwithstanding the request, the second video data is streamed to the user, the user thus being allowed to fast-forward any video data stored on the first member but not being allowed to fast-forward any video data stored on the second member.

The tangible result of the method and product is that a video is streamed to the user, and that the second video data – the part of the video stored on the second member – is streamed to the user notwithstanding an attempt by the user to bypass the second video data. This is quite tangible and concrete, both for the provider streaming the video to the user, as well as the user receiving the video stream.

As to the final paragraph on this subject, the applicant is equally puzzled. This paragraph reads as follows:

The phrase "allowed" at the end of claims 2 and 13. Are absent recitation of any code or steps for causing a computer to do anything, instead just ensuring there's no code or steps which prohibit it, there does not appear to be a useful, concrete and tangible result.

The examiner appears to be requiring each phrase of the claim to produce a concrete and tangible result. None of the authorities cited by the examiner would support such a requirement.

In fact, the law is otherwise. As stated in the passage from *In re Sarkar* quoted by the examiner, "the claimed invention, as a whole, must be evaluated for what it is." (Emphasis added). As the MPEP makes clear,

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting

point for future investigation or research. Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful. [MPEP § 2106, Rev. 3, August 2005, page 2100-6 (citations omitted)]

Thus, the claim as a whole must be evaluated to determine whether it produces a useful, concrete and tangible result. As shown by the applicant above, claims 2 and 13 do produce such a result.

In addition, as explained by the MPEP a page later,

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101." [*Id.*, page 2100-7]

The examiner has not met this burden. The examiner has not shown how the claims as a whole fail to produce a useful, concrete and tangible result. The examiner has not shown the examiner has considered the complete disclosure to determine whether it indicates practical application of the claimed invention. *See*, MPEP page 2100-6, quoted earlier.

Because the examiner has failed to meet the examiner's burden of making a *prima facie* case of unpatentability, the rejection should be withdrawn. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

For the foregoing additional reasons, the rejection of claims 2 and 13 should be withdrawn.

In addition, claim 13 was separately rejected as allegedly being directed to non-statutory subject matter. The examiner stated:

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the

practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory.

The applicant infers from the examiner's underlining that the possible presence of a carrier signal in the claim preamble is a reason for the rejection, and has amended the claim to recite a "computer-readable storage medium storing a computer program product" to obviate this as a grounds for rejection.

Apart from this, the applicant finds the rejection unintelligible. All of paragraph 8 of the detailed action appears to be legal boilerplate. The examiner has not related the legal principles in any way to the language or limitations of claim 13 as a whole. The MPEP reminds examiners that:

Office personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101. The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. [MPEP, *supra*, page 2100-14]

The examiner has not heeded these directions. As explained earlier in these remarks, claim 13 recites substantial functional material that operates to produce a useful, concrete and tangible result. Claim 13 is therefore statutory.

For the foregoing additional reasons, the rejection should be withdrawn..

The foregoing remarks address all of the rejections of the dependent claims of claims 2 and 13, and those rejections should be withdrawn for at least the reasons that apply to their independent base claims.

Claims 6-11 were rejected as if they depending from claim 2 or claim 13. In fact, claim 6 is an independent claim, and the grounds for rejection set forth for claims 2 and 13 do not appear to apply to claim 6 in any way.

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For the foregoing additional reason, the rejection of claims 6-11 should be withdrawn.

Conclusion

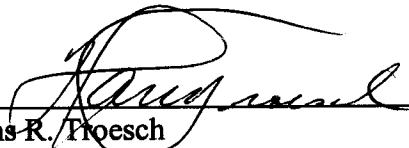
For the foregoing reasons, all of the pending claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 01 Sep 06


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